Appl. No. 10/748,759
Amdt. dated April 3, 2009
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 3622

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REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed January 5, 2009. Claims 1, 2, 4, 6-21, and 35 were pending in the present application. Claims 1, 2, 4, 6-21, and 35 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1, 2, 4, and 6-8 are rejected as allegedly being rendered obvious by *Calabria* (US 2005/0137939) in view of *Bronnimann* (US 2004/0044571). Claims 9-21 and 35 are rejected as allegedly being rendered obvious by *Bronnimann* in view of *Calabria*. In view of the following remarks, reconsideration of the rejected claims is respectfully requested.

I. Claims 1, 2, 4, 6-21, and 35 Are Sufficiently Definite

Claims 1, 2, 4, 6-21, and 35 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the independent claims are rejected as allegedly being unclear as to whether the generators generate the advertisements or the advertisement sets. Although Applicants do not agree with the rejections, these claims have been amended to clarify the subject matter being claimed. It is respectfully submitted that the independent claims as amended, and the claims that depend therefrom, are sufficiently definite. Applicants therefore respectfully request that the §112 rejections with respect to these claims be withdrawn.

II. Claims 1, 2, 4, 6-21, and 35 Are Not Rendered Obvious by *Calabria* and *Bronnimann*

Claims 1, 2, 4, 6-21, and 35 are each rejected under 35 U.S.C. §103(a) as allegedly being obvious over a combination of *Calabria* and *Bronnimann*.

With regard to rejections under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (*i.e.*, the reference teachings establish a *prima facie* case of obviousness) is more probable than not." MPEP §2142. Accordingly, "the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation

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of the reason(s) why the claimed invention would have been obvious." MPEP §2142; see *KSR*

International Co. v. Teleflex, Inc., 550 U.S.__, 82 USPQ 2d 1385 (1395-97 (2007).

Independent Claim 1

Applicants' claim 1 as amended recites a "computer system for requesting advertisements

to be placed along with content on behalf of an advertiser in association with at least one

keyword," comprising:

> a plurality of advertisement generators each operable to automatically generate an advertisement set for the advertiser and the at least one keyword, each advertisement generator including a first algorithm for identifying search terms corresponding to an item to be advertised, a second algorithm for determining at least one creative aspect of an advertisement being created for the item, and a third algorithm for creating a link to information about the item, each generated advertisement set including at least one different advertisement created using the determined creative aspect, the link to information about the item, and at least one search term matching the at least one keyword;
> a fee calculator that calculates fee amounts for each of the advertisement sets generated by the advertisement generators based on anticipated profitability of the advertisement sets;
> an advertisement manager that:
> > receives from the advertisement generators the generated advertisement sets,
> > receives from the fee calculator a fee amount for each of the generated advertisement sets,
> > determines whether an advertisement set is currently submitted to an advertisement placement service for the keyword, and
> > when an advertisement set is not currently submitted to the advertisement placement service for the keyword, selects one of the generated advertisement sets for submission to the advertisement placement service; and
> an advertisement submitter that, when an advertisement set is not currently submitted to the advertisement placement service for the keyword:
> > receives from the advertisement manager the selected advertisement set and the fee amount for the selected advertisement set, and
> > sends to the advertisement placement service a request to place the selected advertisement set along with content associated with the keyword at the fee amount of the selected advertisement set.

Such limitations are neither taught nor suggested by *Calabria* and *Bronnimann*.

For example, and as discussed of record, *Calabria* teaches a "server-based method of

automatically generating a plurality of bids for an advertiser for placement of at least one

advertisement in associated with a search results list" (paragraph [0021]). *Calabria* teaches

"receiving at least one candidate advertisement from the advertiser" then "creating a list of

candidate keywords" and "calculating a bid amount for each advertisement-keyword pair"

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(paragraph [0021]). *Calabria* teaches "an advertisement selection agent (54)" that "includes an algorithm for <u>selection</u> of an advertisement from the advertisement database (46) that is to be matched with a given keyword of keyword combination" (paragraphs [0052] and [0121]). *Calabria* uses "a bidding agent (50)" to "<u>select</u> a corresponding keyword advertisement" and determine a bid to be submitted (paragraph [0042]). *Calabria* thus is directed to <u>selecting an ad</u> from a set of ads, matching candidate keywords with the selected ad, and determining a bid price for the combination.

Calabria does not, however, teach or suggest "a plurality of advertisement generators" as recited in Applicants' claim 1 as amended, where each advertisement generator is "operable to automatically generate an advertisement set for the advertiser and the at least one keyword". *Calabria* also does not teach or suggest that "each advertisement generator" includes "a first algorithm for identifying search terms corresponding to an item to be advertised, a second algorithm for determining at least one creative aspect of an advertisement being created for the item, and a third algorithm for creating a link to information about the item". *Calabria* also does not teach or suggest that "each generated advertisement set" includes "at least one different advertisement having the determined creative aspect, a link to information about the item, and at least one search term matching the at least one keyword".

Bronnimann does not make up for the deficiencies in *Calabria* with respect to Applicants' claim 1 as amended. *Bronnimann* teaches approaches for "<u>varying provided advertisements</u> to increase effectiveness and revenues derived from the advertisements" (paragraph [0002]). *Bronnimann* teaches that "an individual advertiser may be permitted to <u>supply multiple advertisements</u> corresponding to a single keyword bid within a pay-for-placement search engine" paragraph [0009]). In such a system, advertisement providers "connect over a network (14) to an Advertisement Listings Provider (16)" to "register, <u>provide</u> payment information, bids, and <u>associated advertisements (also called creatives)</u> associated with the bid" (paragraph [0041]). *Bronnimann* then determines a "listing of advertisements from the database based on criteria provided and depending on the forum for the advertisements" and can determine an "order to the

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listing" based on factors such as "revenue efficiency", and can submit the ordered advertisements to an advertiser using an "advertiser communication module (38)" (paragraph [0044]).

Bronnimann does not, however, teach or suggest "a plurality of advertisement generators" as recited in Applicants' claim 1 as amended, where each advertisement generator is "operable to automatically generate an advertisement set for the advertiser and the at least one keyword". *Bronnimann* also does not teach or suggest that "each advertisement generator" includes "a first algorithm for identifying search terms corresponding to an item to be advertised, a second algorithm for determining at least one creative aspect of an advertisement being created for the item, and a third algorithm for creating a link to information about the item". *Bronnimann* also does not teach or suggest that "each generated advertisement set" includes "at least one different advertisement, a link to information about the item, and at least one search term matching the at least one keyword".

Thus, even if *arguendo* there were some motivation to combine *Calabria* and *Bronnimann*, the combination still would not render obvious Applicants' claim 1, as the combination still would only process or select from submitted or existing ads. At best, an argument could be made that combination could provide functionality analogous to at least some of that of the advertisement manager of Applicants' claim 1. However, the proposed combination would not teach or suggest "a plurality of advertisement generators" for generating advertisement sets as recited in Applicants' claim 1 as amended. As such, Applicants' claim 1 cannot be rendered obvious by these references.

Further, the Office Action states on pages 4 and 7 that no patentable weight is being given to the generation of the advertisement sets due to the lack of connection between elements in the claim or recitation of the advertisement being created. Applicants respectfully submit that the language has been clarified such that all phrases recited therein should be given patentable weight.

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Claims 2, 4, and 6-8

Claims 2, 4, and 6-8 are allowable over the cited references at least in view of their dependency from claim 1 discussed above. Further, elements of at least some of these claims are also patentable over these references as these elements also are neither taught nor suggested by these references. For example, claim 6 recites "multiple advertisement submitters where each advertisement submitter is associated with an advertisement placement service" and claim 7 recites "a database containing statistics relating to placements of advertisements and wherein the fee calculator determines anticipated profitability based on analysis of the statistics", which are neither taught nor suggested by these references. For at least these reasons, claims such as claims 6 and 7 are allowable in their own right.

Independent Claim 9

Applicants' claim 9 as amended recites, in part, a "method in a computer system for placing advertisements," the method comprising:

> automatically creating at least one advertisement for each of a plurality of advertisement sets being generated using a plurality of advertisement generators, each advertisement generator including a different algorithm for determining at least one creative aspect of the at least one advertisement being created for a respective advertisement set, each advertisement set being generated for the same advertiser and the same keyword and including the at least one automatically created advertisement, the keyword, and a bid amount.

For reasons including at least some of those discussed above, neither *Calabria* nor *Bronnimann*, individually or in combination, teach or suggest each element of this claim. For example, the proposed combination of references fails to teach or suggest "automatically creating at least one advertisement for each of a plurality of advertisement sets being generated using a plurality of advertisement generators" or "each advertisement generator including a different algorithm for determining at least one creative aspect of the at least one advertisement being created for a respective advertisement set" as recited in Applicants' claim 9. As such, Applicants' claim 9 cannot be rendered obvious by these references for at least these reasons.

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Claims 10-21

Claims 10-21 are allowable over the cited references in view of their dependency from claim 9. Further, elements of at least some of these claims are also patentable over these references as these elements also are neither taught nor suggested by these references. For example, claim 13 recites "calculating the bid amount based on advertising metrics", and claim 14 recites "wherein the bid amount is adjusted based on advertising metrics." Further, claim 16 recites "wherein the advertisement set is selected based on effectiveness of the advertisement generator that generated the advertisement sets", claim 20 recites "filtering the generated advertisement sets based on frequency of keywords", and claim 21 recites "filtering the generated advertisement sets based on desirability of keywords". Such elements are neither taught nor suggested by these references. For at least these reasons, claims such as claims 13, 14, 16, 20, and 21 are allowable in their own right.

Further, it is respectfully submitted that elements such as "filtering the generated advertisement sets based on frequency of keywords" and "filtering the generated advertisement sets based on desirability of keywords" as recited in claims 20 and 21, particularly in light of the elements of the respective independent claim, are not rendered obvious by that which is old and well known in the art. Applicants thus respectfully traverse the Official Notice taken in the Office Action. Even if for sake of argument "determining search terms" can depend upon aspects such as frequency or desirability, it is respectfully submitted that it is not known in the art to "filter generated advertising sets" as recited in these claims, and such elements would not be rendered obvious by processes for determining search terms as alleged in the Office Action.

Independent Claim 35

Applicants' claim 35 as amended recites, in part, a "method in a computer system for placing advertisements," the method comprising:

> program code for automatically creating at least one advertisement for each of a plurality
> of advertisement sets being generated using a plurality of advertisement generators, each
> advertisement generator including a different algorithm for determining at least one creative aspect
> of the at least one advertisement being created for a respective advertisement set, each

advertisement set being generated for the same advertiser and the same keyword and including the
at least one automatically created advertisement, the keyword, and a bid amount;
    program code for determining whether an advertisement set is currently submitted for the
keyword;
    program code for, when an advertisement set is not currently submitted for the keyword,
submitting a request to specifying a selected advertisement set for the keyword;
    program code for analyzing an effectiveness of the submitted advertisement set based at
least in part upon a financial benefit of placing the advertisement; and
    program code for subsequently selecting an advertisement set to be submitted for the
keyword based on the analyzing

For reasons including at least some of those discussed above, neither *Calabria* nor *Bronnimann*,
individually or in combination, teach or suggest the elements of this claim as amended. For
example, the proposed combination does not teach or suggest "automatically creating at least one
advertisement for each of a plurality of advertisement sets being generated using a plurality of
advertisement generators" or "each advertisement generator including a different algorithm for
determining at least one creative aspect of the at least one advertisement being created for a
respective advertisement set" as recited in Applicants' claim 35. As such, Applicants' claim 35
cannot be rendered obvious by these references.

Applicants thus respectfully request that the obviousness rejections with respect to the
claims be withdrawn.

III.   Amendment to the Claims

Unless otherwise specified or addressed in the remarks section, amendments to the claims
are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any
equivalents thereof. The amendments are supported by the specification and do not add new
matter. In addition, by focusing on specific claims and claim elements in the discussion above,
applicants do not imply that other claim elements are disclosed or suggested by the references.
In addition, any characterizations of claims and/or cited art are being made to facilitate
expeditious prosecution of this application. Applicants reserve the right to pursue at a later date
any other broader or narrower claims that capture any subject matter supported by the present
disclosure, including subject matter found to be specifically disclaimed herein or by another

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prosecution. Accordingly, reviewers of this or any child or related prosecution history shall not reasonably infer that applicants have made any disclaimers or disavowals of any subject matter supported by the present disclosure.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

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